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PATENT APPLICATION

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42764

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: M. Nguyen
JOHN S. HAIKIN, et al.)
: Group Art Unit: 2626
Application No.: 09/540,012)
: Filed: March 31, 2000)
: For: COLOR MANAGEMENT)
: SYSTEM USING MEASURED) April 12, 2004
: DEVICE DATA)

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Technology Center 2600

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT
AND
REQUEST TO CLARIFY ELECTION REQUIREMENT

Sir:

In response to the requirement for restriction entered by the Office Action dated March 10, 2004 (Paper No. 10), Applicants provisionally elect the Group I claims, namely Claims 1 to 50 and 88 to 90. The requirement to restrict is, however, traversed.

Traversal is on the grounds that the Office Action has failed to establish the predicates required for restriction under M.P.E.P. § 806.05(d) ("Subcombinations Usable Together"). According to M.P.E.P. § 806.05(d), restriction is permitted if two or more

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Michael K. O'Neill, Reg. No. 32,622
(Name of Attorney for Applicant)

Signature

April 12, 2004
Date of Signature

subcombinations are claimed that are separately usable, if the subcombinations are also disclosed as usable together in a single combination. Here, however, in entering the restriction requirement, the Office Action mischaracterized the claims. For example, it was said that the Group I claims were directed to transformation of “source color image data from a source device into destination color image data”, whereas the Group II claims were directed to transformation of “source color image data for rendering by a destination device”. Actually, the preambles of the Group I and Group II claims are identical, and read as follows:

“A method for managing color data to transform source color image data from a source device into destination color image data for rendering by a destination device, said method comprising ...”

Likewise, and unlike the characterization given in the Office Action, the preambles of the Group III and Group IV claims are identical and read as follows:

“A memory for access by a color management system, the color management system for transforming source color image data from a source device into destination color image data for rendering by a destination device, said memory comprising ...”

It is therefore incorrect to state that the claims are directed to subcombinations disclosed as usable together in a single combination, such that the predicates required by M.P.E.P. § 806.05(d) cannot be established. Withdrawal of the restriction requirement is therefore respectfully requested, together with an action on the merits of all of Claims 1 through 90.

To the extent that the request for withdrawal of restriction is not granted, then in the alternative, it is respectfully requested to reformulate the restriction requirement

into no more than two groups: a first group of Claims 1 to 51 and 88 to 90 (i.e., a combination of present Groups I and II), and a second group of Claims 52 to 87 (i.e., a combination of present Groups III and IV). In this alternative, an action on the merits of Claims 1 to 51 and 88 to 90 is respectfully requested.

REQUEST FOR CLARIFICATION OF ELECTION REQUIREMENT

The Office Action further required an election of species, but Applicants are unable to respond to this requirement and respectfully request clarification of it. In this regard, a telephone call was made to the Examiner in an attempt to obtain clarification, but it was agreed during the telephone call that the best manner for obtaining clarification would be a written request for one.

In this regard, Applicants are unable to comply with the requirement to elect between different species for the reason that the Office Action did not designate any species at all. M.P.E.P. § 806.04(e) pointedly explains that “species are always the specifically different embodiments” of the embodiments disclosed in the specification. However, the Office Action did not identify any such different embodiments. Rather, the Office Action identified a laundry list of features, with all of these features being drawn directly from the language of the claims. This is contrary to the procedure outlined at M.P.E.P. § 806.04(e), which specifically cautions that “claims are never species”.

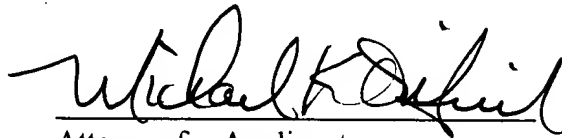
Accordingly, Applicants are unable to comply with the requirement to elect between species, since Applicants are unsure of what is required of them. Clarification is

respectfully requested, although it is believed that upon further reflection, the Examiner will agree that an election between species is not appropriate.

CONCLUSION

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicants.

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